

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 are rejected under 35 U.S.C. 102(b) as being anticipated by Saito et al (WO 03/046263).

[The effective filing date of this application for purposes of 35 U.S.C. 102 is considered to be the filing date of PCT/JP05/06208, of which the present application is a national stage entry. Applicants' claim for foreign priority is noted, but a certified English translation of the prior foreign application has not been filed, such that an earlier effective filing date cannot be granted.]

Saito et al anticipate the invention as claimed. Saito et al teach (see abstract, figure 9 and related description, pages 18-19) an electrolytic processing apparatus including a feed electrode (236) configured to feed an electric current to a conductive material formed on a workpiece (W), a contact member ((230a or 230b) configured to be brought into contact with or close to the workpiece, a process electrode (232) operable to perform an electrolytic process on the conductive material formed on the workpiece, an electrolytic processing liquid source ("liquid B") operable to supply an electrolytic processing liquid between the workpiece and the contact member, a regeneration liquid chamber (240a) configured to immerse the process electrode in a

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regeneration liquid, a regeneration liquid supply source ("liquid A") operable to supply the regeneration liquid to the regeneration liquid chamber, a regeneration electrode (248) spaced from the process electrode, a power supply (246 and 249) operable to apply a voltage between said feed electrode, said process electrode and said regeneration electrode and a controller operable to control the voltage applied between the three electrodes so that the feed electrode has the highest potential, followed by the process electrode, with the regeneration electrode having the lowest potential.

Regarding claim 5, Saito et al teach contact member (230a or 230b) being an ion exchanger.

Regarding claim 6, the process electrode (232) of Saito et al was liquid permeable.

Regarding claim 7, the controller of Saito et al was operable to control the potential and/or current flowing between the three electrodes.

Regarding claim 8, given the ability of the controller of Saito et al to control the current flowing through the process electrode, it would have been capable of setting such current to be 1 to 30% of the current flowing through the feed electrode or regeneration electrode.

Allowable Subject Matter

3. Claims 2-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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4. The following is a statement of reasons for the indication of allowable subject matter: claim 2 requires the presence of a liquid permeable insulation member between the contact member and the process electrode. Saito et al included a member (238a) between the contact member (230a) and the process electrode (232), but describes the member (238a) as an ion exchanger which was designed to inhibit permeation therethrough of liquid (see page 11), thus teaching away from making a liquid permeable insulation member between the contact member (230) and the process electrode (232).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry D. Wilkins, III whose telephone number is 571-272-1251. The examiner can normally be reached on M-F 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexa Neckel can be reached on 571-272-1446. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harry D Wilkins, III/
Primary Examiner, Art Unit 1795

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